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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,239	01/31/2002	Satoshi Mochizuki	219007US0	6551
22850	7590	03/18/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			DOTE, JANIS L	
			ART UNIT	PAPER NUMBER
			1756	
DATE MAILED: 03/18/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/059,239

Applicant(s)

MOCHIZUKI ET AL.

Examiner

Janis L. Dote

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 and 9-19 is/are allowed.
- 6) ☒ Claim(s) 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/22/03; 3/3/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on Mar. 3, 2004, has been entered.

2. The examiner acknowledges the amendment to claim 8 filed on Jan. 5, 2004 (Amdt010504), which was entered upon the filing of the RCE. Claims 1-19 are pending.

3. The examiner has considered only the material submitted by applicants, i.e., copies of the originally filed claims, abstracts, and figures of the US applications listed in the Information Disclosure Statements filed on Dec. 22, 2003, and Mar. 3, 2004, respectively.

4. The objection to the specification set forth in the office action mailed on Sep. 3, 2003 (CTFR090303), paragraph 5, has been withdrawn in response to the amended paragraphs beginning

at page 10, line 20, and page 20, line 6, and amended Table 2 of the specification, filed in Amdt010504.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Currently amended claim 8 recites an electrophotographic color image forming apparatus comprising a developing unit, wherein the developing unit comprises a developer bearing member, a developer regulating member, and a toner vessel containing the dry toner according to claim 1.

Applicants state that support for the developing unit recited in Claim 8 is found at page 17, lines 29-30 ("developing bearing member") and line 35 ("developer regulating member"). See Amdt010504, page 10, lines 2-5.

However, the originally filed specification does not provide an adequate written description of the claimed apparatus. The originally filed specification at page 4, lines 4-6, discloses a one-component developing unit. See Fig. 1. The specification further discloses that in the apparatus of Fig. 1 the one-component developing unit comprises, in addition to a vessel 8 containing toner, a developer bearing member 2, such as a developing cylinder, a developer regulating member 4, a toner supplying member 3, and a stirrer blade 5 in the vessel 8. See the specification, page 17, line 27, to page 18, line 5. The developing unit recited in instant claim 8 is broader than the disclosed one-component developing unit in Fig. 1, because it includes one-component developing units that do not comprise a toner supplying member and a stirrer, and it also includes two-component developing units.

Applicants' arguments filed in Amdt010504 have been fully considered but they are not persuasive.

Applicants assert that the developing unit recited in claim 8 is not limited to a one-component developing unit. Applicants argue that the specification discloses color image forming apparatuses with two-component developing systems, citing examples 2 and 3 of the specification.

Although the originally filed specification discloses that the toner may be used in a color image forming apparatus with a two-component developing system, such as the commercially available imaging apparatuses PRETER 550 and IMAGIO MF2700, there is no evidence on the present record to show that those imaging apparatuses comprise a developing unit comprising a developer bearing member and a developer regulating member as recited in instant claim 8. The copy of the Ricoh Technical Report No. 22, July 1996, with the verified hand-written English-language notations, filed on Jan. 3, 2004, does not provide an adequate written description of a two-component developing unit as recited in instant claim 8. The English-language notations merely recite a "dry 2-component magnetic brush developing unit." The figure shown on page 131 of the report does not show that the two-component developing unit comprises the components recited in instant claim 8.

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7. Claims 1-7 and 9-19 are allowable over the prior art of record for the reasons discussed in the office action mailed on Mar. 19, 2003, paragraph 5, which are incorporated herein by reference.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The central fax phone number is (703) 872-9306.

Any inquiry of papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLD

Mar. 12, 2004

Janis L. Dote
JANIS L. DOTE
PRIMARY EXAMINER
GROUP 1500
1700